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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,769	03/18/2004	Tohru Harada	250617US2	4671

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
MORRISON, JAY A	

ART UNIT	PAPER NUMBER
2168	

NOTIFICATION DATE	DELIVERY MODE
07/14/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/802,769	HARADA ET AL.	
	Examiner	Art Unit	
	JAY A. MORRISON	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/7/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. Claims 1-21 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paradinas et al. ('Paradinas' hereinafter) (Publication Number 2002/0116478) in view of Shields et al. ('Shields' hereinafter) (Publication Number 2003/0225797).

As per claim 1, Paradinas teaches

A file creation method which creates a program-addition file for adding a program to a program-initiation recording medium of an information processing apparatus, comprising the steps of: (see abstract and background)

acquiring identification information of the program-initiation recording medium (description when card connected, paragraph [0041]) in response to a program adding request received from a computer terminal connected to the information processing apparatus via a network; (request from device to install from card, paragraph [0049], lines 5-13; over network, paragraph [0060], lines 18-22)

and creating a program-addition file in response to the identification information so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium. (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

Paradinas does not explicitly indicate “and model identification of the information processing apparatus” nor “and the model identification”.

However, Shields discloses “and model identification of the information processing apparatus” and “and the model identification” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “and model identification of the information processing apparatus” and “and the model identification” would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 2, Paradinas teaches

the step of transmitting the program-addition file to the information processing apparatus via a network. (paragraph [0024])

As per claim 3, Paradinas teaches

the step of storing the program-addition file in a program-addition recording medium (paragraph [0040])

which is used for the addition of the program to the program-initiation recording medium. (Minton v. Nat '1Ass'n of Securities Dealers, Inc., 336 F.3d 1373, 1381,67 USPQ2d 1614, 1620 (Fed. Cir. 2003) "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited."

Examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B)"wherein" clauses; and (C)"whereby" clauses. Therefore intended use limitations are not required to be taught, see MPEP § 2106 Section II(C), MPEP 2111.04 [R-3])

As per claim 4, Paradinas teaches

in the acquiring step, the identification information is acquired from a predetermined information provider device. (paragraph [0055])

As per claim 5, Paradinas teaches

the program-addition file comprises a program file, an electronic signature of the program file, a configuration file, and an electronic signature of the configuration file, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium. (paragraphs [0039]-[0041])

As per claim 6, Paradinas teaches

the creating step comprises: acquiring the program file, the electronic signature of the program file, and the configuration file; (paragraphs [0039]-[0041])

and creating a second electronic signature of the configuration file based on the identification information of the program-initiation recordiag medium and the acquired configuration file. (paragraphs [0039]-[0041])

As per claim 7, Paradinas teaches

the program file, the electronic signature of the program file, and the configuration file are acquired from a predetermined information provider device. (paragraph [0055])

As per claims 8-9,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-2 and are similarly rejected.

As per claim 10, Paradinas teaches

a file transmitting unit transmitting the program-addition file to a computer terminal in which the program-addition file is stored in a program-addition recording medium. (paragraphs [0039]-[0041])

As per claim 11,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 12, Paradinas teaches

A computer terminal which stores a program-addition file in a program-addition recording medium, the program-addition file being used to add a program to a program-initiation recording medium of an information processing apparatus, the computer terminal comprising: (see abstract and background)

an information transmitting unit transmitting, to a server, a program adding request, which causes the server to acquire identification information of the program-initiation recording medium (description when card connected, paragraph [0041]) in response to the program adding request (request from device to install from card, paragraph [0049], lines 5-13; over network, paragraph [0060], lines 18-22);

a file receiving unit receiving, from the server, a program-addition file which is created by the server in response to the identification information so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium; (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

and a file storing unit storing the received program-addition file into the program-addition recording medium. (communication protocol, paragraph [0049])

Paradinas does not explicitly indicate “and model identification of the information processing apparatus” nor “and the model identification”.

However, Shields discloses “and model identification of the information processing apparatus” and “and the model identification” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “and model identification of the information processing apparatus” and “and the model identification” would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 13, Paradinas teaches

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 14,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected.

As per claim 15,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 16, Paradinas teaches

An information processing apparatus which adds a program to a program-initiation recording medium by using a program-addition recording medium in which a program-addition file for adding the program to the program-initiation recording medium is stored, the information processing apparatus comprising: (see abstract and background)

a recording-medium detection unit detecting the program-addition recording medium in which the program-addition file is recorded; (communication protocol, paragraph [0049])

and a program addition unit performing an authentication check of the program-addition file read from the program-addition recording medium, and adding the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

Paradinas does not explicitly indicate "based on model identification of the information processing apparatus".

However, Shields discloses "based on model identification of the information processing apparatus" (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of "based on model identification of the information processing apparatus" would have

given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 17, Paradinas teaches

when there are two or more program-initiation recording mediums, the program addition unit displays a screen to select one of the program-initiation recording mediums, and adds the program to the selected program-initiation recording medium. (paragraph [0025])

As per claim 18, Paradinas teaches

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 19, Paradinas teaches

A program addition system comprising: (see abstract and background)

a server which creates a program-addition file for being stored in a program-addition recording medium; (application developed and stored as executable code, paragraphs [0039]-[0040])

and an information processing apparatus which adds a program to a program-initiation recording medium by using the program-addition recording medium, (application stored on smart card, paragraphs [0039]-[0040])

wherein the server is configured to acquire identification information of the program-initiation recording medium, in response to a program adding request received from a computer terminal connected to the information processing apparatus via a network, and to create a program-addition file in response to the identification information, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium, (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041]; request from device to install from card, paragraph [0049], lines 5-13; over network, paragraph [0060], lines 18-22)

wherein the information processing apparatus is configured to detect the program-addition recording medium in which the program-addition file is recorded, (communication protocol, paragraph [0049]) to perform an authentication check of the program-addition file read from the program-addition recording medium, and to add the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

Paradinas does not explicitly indicate “and model identification of the information processing apparatus” nor “and the model identification”.

However, Shields discloses “and model identification of the information processing apparatus” and “and the model identification” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “and model identification of the information processing apparatus” and “and the model identification” would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 20, Paradinas teaches

A program addition system comprising: (see abstract and background)

a server which creates a program-addition file for being stored in a program-addition recording medium; (application developed and stored as executable code, paragraphs [0039]-[0040])

and an information processing apparatus which adds a program to a program-initiation recording medium by using the program-addition recording medium, (application stored on smart card, paragraphs [0039]-[0040])

wherein the server is configured to acquire identification information of the program-initiation recording medium, in response to a program adding request received from a computer terminal connected to the information processing apparatus via a

network, and to create a program-addition file in response to the identification information, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium, (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041]; request from device to install from card, paragraph [0049], lines 5-13; over network, paragraph [0060], lines 18-22)

wherein the information processing apparatus is configured to receive the program-addition file from the server, (communication protocol, paragraph [0049]) to perform an authentication check of the received program-addition file, and to add the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

Paradinas does not explicitly indicate “and model identification of the information processing apparatus” nor “and the model identification”.

However, Shields discloses “and model identification of the information processing apparatus” and “and the model identification” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “and model identification of the information processing apparatus” and “and the model

identification" would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 21,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

Response to Arguments

4. Applicant's arguments filed 3/27/08 have been fully considered but they are not persuasive.

With respect to claims 1 and 16, Applicant argues that neither Paradinas nor Shields disclose "acquiring identification information of the program-initiation recording medium and model identification of the information processing apparatus" or "creating a program-addition file in response to the identification information and the model identification". Applicant further argues that the Office Action sent 12/27/2007 takes the position that Shields teaches the acquiring and creating steps. Respectfully, it is noted that Paradinas is disclosed as teaching the claimed "acquiring identification information of the program initiation recording medium" as obtaining an application description when

the smart card is connected (paragraph [0041]), and not the Shields reference as argued by the Applicant. In addition, it is respectfully noted that Paradinas also discloses "creating a program-addition file in response to the identification information in response to the identification information" as the description and application stored on the smart card to be executed when the smart card is connected to the device (paragraphs [0039]-[0041]), and not the Shields reference as argued by the Applicant. It is respectfully noted that the model identification of the processing apparatus, which is a portion of the limitation argued by the Applicant, is in fact shown as being taught by Shields in the aforementioned Office Action. However, the teaching of Shields is limited to this portion of the limitation, which shows a model number of a device (paragraph [0047], lines 8-12), although the model number is non-functional in the claim regardless and therefor could be most any information associated with a device. Therefore it is respectfully submitted that Paradinas in view of Shields discloses the limitations in question.

5. With respect to claims 2-15 and 19-21, Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 2, 2008

Jay Morrison
TC2100

Tim Vo
TC2100

/Pierre M. Vital/
Supervisory Patent Examiner, Art Unit 2169

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/802,769	HARADA ET AL.	
	Examiner	Art Unit	
	JAY A. MORRISON	2168	